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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,000	09/27/2001	Peter-Roger Nyssen	Mo-6631/LeA 33,423	8890

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BAYER CHEMICALS CORPORATION  
100 BAYER ROAD  
PITTSBURGH, PA 15205

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/938,000

Applicant(s)

NYSSEN, PETER-ROGER

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. The preliminary amendment submitted on 27 September 2001 has been entered. Claims 1-9 were canceled and claims 10-21 were added.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has not adequately described the standard of "ISO 1524:1983". This is recited in the specification however applicant does not describe what the test or standard entails.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1755

Claim 10 is confusing as written as it is unclear as to just what applicant is trying to claim due to the limitation "when dispersed....components and water". What is meant by this phrase? When are the components dispersed? The limitation "when dispersed....components and water" is not a positive claim recitation.

In claim 12 the phrase "the solid component a) is used" is confusing as it is unclear as to what is meant by "used". What is the component used as and when is it used?

In claim 21 the phrase "an effective amount" is vague and indefinite as it is unclear as to the amount encompassed by the phrase. That is, an amount effective to do what? Clarification is requested.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 10-11 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 04-174795.

Art Unit: 1755

The reference teaches a dispersion of a fine powder of  $\text{SiO}_2$  in starch. The  $\text{SiO}_2$  has a particle size of 1 to 20 nm.

The instant claims are met by the reference. It is the position of the examiner that the components of the dispersion meet applicants claimed limitations due to fact that the  $\text{SiO}_2$  is already in a very fine particle state therefore little or no energy is needed to produce the dispersion having a particle size of less than 60 microns. . Accordingly the burden of proof is on the applicant to show that the reference would not produce a dispersion having the claimed particle size.

8. Claims 10-11, 15, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Satake et al (US Patent No. 5,814,685).

The reference teaches, in the tables, various pigment dispersions comprising a pigment and a resin in an aqueous resin. Both the pigment and the resin particles have an extremely small particle size.

The instant claims are met by the reference. It is the position of the examiner that the components of the dispersion meet applicants claimed limitations due to fact that both of the particles (pigment and resin) are already in a very fine particle state therefore little or no energy is needed to produce the dispersion having a particle size of less than 60 microns. Accordingly the burden of proof is on the applicant to show that the reference would not produce a dispersion having the claimed particle size.

Art Unit: 1755

9. Claims 10-11, 15 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lat (US Patent No. 4,430,367).

The reference teaches, in the examples (see especially example 1), an aqueous composition for forming a translucent stain absorbent film comprising an acrylic resin and a water insoluble extended pigment. The particle size of the acrylic resin is less than 0.1 micron and the particle size of the pigment averages 6 microns.

The instant claims are met by the reference. It is the position of the examiner that the components of the dispersion meet applicants claimed limitations due to fact that both of the particles (pigment and resin) are already in a very fine particle state therefore little or no energy is needed to produce the dispersion having a particle size of less than 60 microns. Accordingly the burden of proof is on the applicant to show that the reference would not produce a dispersion having the claimed particle size.

10. Claims 10-11, 15-16 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Mackawa et al (US Patent No. 6,451,901).

The reference teaches, in the examples, the formation of aqueous dispersions of block copolymer particles having a particle size of less and calcium carbonate having mean particle size of 0.3 microns.

The instant claims are met by the reference. It is the position of the examiner that the components of the dispersion meet applicants claimed limitations due to fact that both of the particles (pigment and resin) are already in a very fine particle state therefore little or no energy is needed to produce the dispersion having a particle size of

Art Unit: 1755

less than 60 microns. Accordingly the burden of proof is on the applicant to show that the reference would not produce a dispersion having the claimed particle size.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lat (US Patent No. 4,430,367), Satake et al (US Patent No. 5,814,685) and Maekawa et al (US Patent No. 6,451,901).

The instant claims are obvious over the reference. While the references do not recite the use of same method to obtain the solid component it is the position of the examiner that it would have been obvious to one of ordinary skill in the art to utilize any well known method to produce the solid component particles, absent evidence showing otherwise.

13. Claims 10-12, 15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino et al (US Patent No. 4,243,565).

The reference teaches aqueous dispersion type coating compositions comprising a homogenous mixture of an aqueous medium, synthetic resin particles and a scaly aluminum pigment (see the abstract and the claims). Column 4, lines 3+, recite that the

Art Unit: 1755

resin particles have a particle size of from 0.5 microns however best results are obtained using particles in the range of from 1 to 30 microns (see also claim 1). Lines 33+ of column 4, teach that the scaly aluminum pigment has a flat particulate form in which the short diameter:long diameter ratio is 1: at least 10 and the long diameter is not larger than 100 microns with less than 30 microns being preferred.

The instant claims are obvious over the reference. While the reference does not specifically provide an example wherein an aluminum having a particle size of less than 30 microns is utilized it does teach that this size is preferred. Accordingly it would have been obvious to use the smaller size for the aluminum pigment. It is the position of the examiner that the components of the dispersion meet applicants claimed limitations due to fact that both of the particles (pigment and resin) are already in a very fine particle state therefore little or no energy is needed to produce the dispersion having a particle size of less than 60 microns. Accordingly the burden of proof is on the applicant to show that the reference would not produce a dispersion having the claimed particle size. Also, while the references do not recite the use of same method to obtain the solid component it is the position of the examiner that it would have been obvious to one of ordinary skill in the art to utilize any well known method to produce the solid component particles, absent evidence showing otherwise.

***Allowable Subject Matter***

14. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of



Art Unit: 1755

the base claim and any intervening claims and provided applicant overcomes all of the 35 USC 112, second paragraph rejections.

***Information Disclosure Statement***

15. The references cited by applicant have been considered however they are not seen to teach and/or fairly suggest the instant invention.


***References Cited By The Examiner***

16. The references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 703-308-3819. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
August 25, 2003